REMARKS

I. Status of the Claims

Claims 13-37 and 39-47 are pending in the application, claims 1-12, 38 and 48-50 having been previously canceled. Claims 13-24 stand rejected for alleged lack of enablement under 35 U.S.C. §112, first paragraph, and claims 20, 21, and 31-33 stand rejected alleged obviousness under 35 U.S.C. § 103, respectively. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

Please note that claims 25-30, 34-37 and 39-47 remain pending but no grounds for rejection is provided. Applicants request either (a) clarification that these claims are allowed, or (b) a non-final action that sets forth any pending rejection.

II. Rejection Under 35 U.S.C. §112, First Paragraph

Claims 13-24 remain rejected under §112, first paragraph as lacking enablement. The examiner states that while arguably providing support for the treatment of lymphatic cancer, the specification lacks adequate support for preventing cancer generally. Applicants traverse.

The examiner's criticisms of applicants' position are as follows. First, it is argued that applicants provide only a single example of cancer treatment, but fail to provide broad support for cancer prevention. Once again, applicants point out that the claim is drawn to "prevention of metastasis," not "prevention of cancer." Regardless, it is the examiner's burden to establish why one of skill in the art would not be convinced, in light of the evidence provided by applicants, that hyaluron could be used to treat a variety of cancers. The record is largely silent on this issue, save for a single comment that predicting who will get cancer is "unpredictable." ***Since***

prevention of cancer is not being claimed, applicants submit that the examiner's position is unsupportable as lacking any reasonable basis.

Second, it is argued that there is no declaration on file showing *in vivo* efficacy. This argument is, however, irrelevant. Applicants' disclosure, as argued previously, indeed provides evidence of *in vivo* efficacy for hyaluronan in the prevention of metastasis - see Example 4 and FIG. 6 (mice treated with the claimed HA therapy showed a significant reduction in non-lymphoid metastasis, as compared to mice not receiving the therapy). Thus, the question is one of ***evidence***, and not the form in which it is presented. Again, the examiner's position is thus unsupportable.

In light of the preceding discussion and evidentiary submission, applicants again respectfully request reconsideration and withdrawal of the rejection as based on an improper analysis under *In re Wands*.

III. Rejection Under 35 U.S.C. §103

Claims 20, 21, 30, 31 and 50 stand rejected as obvious over Harper *et al.* in view of Falk *et al.* ("the '834 patent"). Harper is said to teach topical compositions of hyaluronic acid to effect transfer of drugs across the dermal barrier. The '834 patent is cited as teaching the combination of an antineoplastic agent mixed with hyaluronic acid for the treatment of carcinoma of the bladder with pelvic metastasis. It also is said to teach HA delivery before or after the antineoplastic agent. Thus, the examiner concludes that one of skill in the art would have been motivated to combine HA with an antineoplastic agent for the purpose of improved bioavailability in the treatment of cancer. Applicants traverse.

Once again, applicants remind the examiner that in order to combine two references, they must posit their own combination. Here, using complete hindsight, the examiner has matched references without regard to any scientific reasoning. The '088 patent merely employs HA as an inert, carrier molecule, and the '834 patent uses it as a therapeutic – why would combine their teachings? No answer is provided..

Next, the rejected claims all carry limitations of hyaluron having a molecular weight of 750,000 to 1,500,000, whereas the '088 and '834 patents suggest use of HA of ***less*** than 750,000 daltons, providing yet another reason that the rejection is faulty. The examiner's response is that because the references teach the recited composition, it is applicants' burden to establish criticality of the recited limitations. There is no such legal requirement under the present fact scenario, and thus applicants disagree.

Rather, it is the examiner's burden to establish why one would modify the primary reference to arrive at the present invention – in this case one that teaches using hyaluron as a carrier – to arrive at a therapeutic composition. A reading of the secondary reference reveals that if one ***were*** inclined to modify the primary reference to make it a therapeutic, then one would use ***lower*** molecular weight hyaluron, not HA of greater than 750,000. Thus, there is no basis for the alleged *prima facie* case advanced by the examiner.

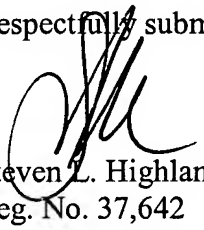
For all of the foregoing reasons, applicants again respectfully submit that the claimed invention is distinct from that described in the prior art. Reconsideration and withdrawal of the rejection is therefore requested.

V. Conclusion

In light of the foregoing, applicants submit that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should the examiner have any questions regarding the content of this preliminary amendment, a telephone call to the undersigned is invited.

Please date stamp and return the enclosed postcard as evidence of receipt.

Respectfully submitted,



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